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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/759,986 | 01/12/2001 | Sally J. Bull | 52355 USA9B.014 | 3145 |

7590 11/21/2002

Office of Intellectual Property
3M Innovative Property Counsel
P.O. Box 33427
St. Paul, MN 55133-3427

| EXAMINER |
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AHMAD, NASSER

| ART UNIT | PAPER NUMBER |
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1772

10

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 10

Office Action Summary

Application No.
09/759,986

Applicant(s)
Bull et al.

Examiner
Nasser Ahmad

Art Unit
1772



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 9, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 31-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 9 6) ☐ Other:

1. Attached to this Office Action is a copy of the IDS (Paper No. 4) that was inadvertently left out when the last Office Action was mailed. The PTO-1449 form has been initialed and dated.
2. Claims 1-24 and 31-35 are rejected under 35 USC 103(a) as being unpatentable over Andriash in view of Bull for reasons of record in Paper No. 7, paragraph 2, mailed on May 10, 2002.
3. Declaration under 37 CFR 1.132 filed on April 23, 2001 by Ms. Sally Bull is insufficient for reasons of record in Paper No. 7, paragraph – 4.
4. Applicant's arguments filed August 9, 2002 have been fully considered but they are not persuasive. Applicant argues that Bull is directed to an overlamine comprising a clear film having adhesive on only one side and not a scrim with a PSA on one side and a hot melt adhesive on the other side. This is not deemed to be persuasive because Bull teaches, in page 1, that the transparent over laminate can have hot melt adhesive and a scrim liner. The scrim would provide for the adhesive to be on both sides of the scrim because it is well known that scrim is porous. Since, the hot melt adhesive or PSA can be on both sides of the scrim and that either of said adhesive includes the other, the Bull reference provides for a double-sided adhesive laminate.

Contrary to applicants' allegation, the claims fails to recite that the two adhesives are different and cannot be read thereinto for the purpose of avoiding the applied prior art. Applicant should note that hot melt adhesive can be and includes pressure sensitive adhesive. Hence, the two adhesive are not necessarily different as alleged.

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Thus Bull clearly teaches adhesive/scrim/adhesive and that the adhesive can be as claimed. In response to the previously submitted declaration by Ms. Sally Bull, applicant has argued by showing various methods for serving liner as a scrim to a hot melt adhesive such as by casting hot melt adhesive and then fusing it to the liner. However, it is still unclear as to how is the securing "releasable" under said conditions.

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the instant claimed invention is obvious over the prior art of record discussed above.

5. The nonstatutory rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 442 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application is shown to be commonly owned with this application. See 37 CFR 130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-24 and 31-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-40 of U.S. Patent No. 09/098,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and co-pending application '702 are directed to a graphic article having one vary vision property. However, application '702 recites an electrolunirescent film, which would be obviously included in the recited film in the instant application.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-24 and 31-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The "scrim" in the specification defines it away from the standard definition of scrim, which is a porous sheet.

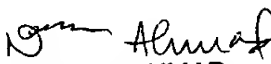
9. Any inquiry concerning this communication the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can generally be reached on Monday-Thursday from 7:30 a.m. to 5 p.m. and on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

N. Ahmad/dh
November 19, 2002


NASSER AHMAD
PRIMARY EXAMINER